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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/496,444	02/02/00	TAO	1189

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EXAMINER  
COLLINS, C

ART UNIT 1638	PAPER NUMBER 4
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DATE MAILED:

01/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/496,444

Applicant(s)

TAO ET AL.

Examiner

Cynthia Collins

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-63 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Elect ion/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-19, 22-25, and 27-53, drawn to isolated nucleic acids, a vector, an expression cassette for sense expression of a nucleic acid, host cells, plants, seeds, and a method of modulating the level of CycE protein in a cell by transformation with an expression cassette, classified in class 536, subclass 23.6, for example.
  - II. Claims 1, 11, 13-19, 23-25, and 27-53, drawn to isolated nucleic acids, a vector, an expression cassette for antisense expression of a nucleic acid, host cells, plants, seeds, and a method of modulating the level of CycE protein in a cell by transformation with an expression cassette, classified in class 435, subclass 320.1, for example.
  - III. Claims 20-21, drawn to an isolated protein, classified in class 530, subclass 300, for example.
  - IV. Claims 26 and 54, drawn to a method of modulating the level of CycE protein in a cell by transformation with RNA, classified in class 435, subclass 440, for example.
  - V. Claim 55, drawn to a method for transiently modifying the level of CycE protein in plant cells by transformation with polypeptides, classified in class 800, subclass 276, for example.

- VI. Claims 9 and 56, drawn to a method for identifying CycE interacting proteins, classified in class 435, subclass 7.1, for example.
- VII. Claims 57-61, drawn to a method for increasing transformation efficiency, classified in class 800, subclass 276, for example.
- VIII. Claims 62-63, drawn to a method for transiently modifying the level of a CycE protein in a recipient cell, classified in class 435, subclass 468, for example.

2. The inventions are distinct, each from the other because of the following reasons: The inventions of Groups I -III are distinct products because the isolated nucleic acids of Groups I and II are chemically, structurally, and functionally distinct from the isolated polypeptide of Group III. The inventions of Groups I-VIII are distinct methods given that each method requires different method steps and different components. Also, the isolated nucleic acids and polypeptides of Groups I -III can be used in methods other than those claimed. For example, the expression cassette of Group I could be used to make a recombinant polypeptide, the expression cassette of Group II could be used to make RNA, and the isolated polypeptide of Group III could be used as an immunogen for the production of antibodies. Thus the inventions of Groups I-VIII are each capable of being separately made, independently used and the patentability of one would not render the other obvious or unpatentable.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

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4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:15 AM -4:45 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached on (703) 308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and 1 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Cynthia Collins  
December 28, 2000

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1600

